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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/009,248	01/20/1998	KENJI OSAWA	P972636	7174

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 11/23/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/009,248

Applicant(s)

OSAWA ET AL.

Examiner

David E Graybill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: The full name of each inventor (family name and at least one given name together with any initial) has not been set forth. Specifically, the full name of Kenji Ohsawa, as signed, has not been set forth.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a),

the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 and 10-12 are rejected under 35 U.S.C. 102(e) as anticipated by Ohsawa or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ohsawa (5756377).

At column 4, lines 25-29; column 5, lines 8-11; column 6, lines 53-56; column 7, line 67 to column 8, line 7; and column 9, line 18 to column 10, line 17 Ohsawa teaches:

1. A semiconductor device comprising: a semiconductor chip 4 having a plurality of electrode pads formed at a periphery of a front surface thereof; a wiring film formed on a front surface side of said semiconductor chip by laminating an insulation film 6 on a lead 13 pattern; an outer connection terminal 7 formed so as to protrude above said wiring film; a plurality of leads 13 extending from said wiring film and connected to the electrode pads on said semiconductor chip at extended tip ends 13i

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thereof; an external ring 10 provided so as to surround said semiconductor chip and formed with a plurality of through holes or blind holes positioned entirely outside of a perimeter edge of the semiconductor chip; and a sealing resin 8 filled between said semiconductor chip and said external ring.

2. A semiconductor device according to claim 1, further comprising an outwardly expanded open portion formed on an inner circumferential surface of said external ring and positioned on a rear surface side of said semiconductor chip.

3. A lead frame comprising: a wiring film formed by laminating an insulation film 6 on a lead 13 pattern; an external connection terminal 7 formed so as to protrude above said wiring film; a plurality of leads 13 extending from said wiring film and forming connecting portions to electrode pads on a semiconductor chip 4 at extended tip ends 13i thereof; and an external ring 10 provided outside said wiring film, having an opening portion capable of housing said semiconductor chip and formed with a plurality of through holes or blind holes positioned entirely outside of a perimeter edge of the semiconductor chip when the opening portion houses the semiconductor chip.

4. A lead frame according to Claim 3, further comprising an outwardly expanded open portion formed on an inner

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circumferential surface of said opening portion of said external ring and positioned on a rear surface side of said semiconductor chip.

5. An electronic apparatus including a printed wiring board loaded with a semiconductor chip, said semiconductor device comprising: a semiconductor chip 4 having a plurality of electrode pads formed at a periphery of a front surface thereof; a wiring film formed on a front surface side of said semiconductor chip by laminating an insulation film 6 on lead 13 patterns; an outer connection terminal 7 formed so as to protrude above said wiring film; a plurality of leads 13 extending from said wiring film and connected to the electrode pads on said semiconductor chip at extended tip ends 13i thereof; an external ring 10 provided so as to surround said semiconductor chip and, formed with a plurality of through holes or blind holes positioned entirely outside of a perimeter edge of the semiconductor chip; and a sealing resin 8 filled between said semiconductor chip and said external ring, wherein said external connection terminal and an electrode on said printed wiring board are connected.

6. An electronic apparatus according to Claim 5, further comprising an outwardly expanded open portion formed on an inner

circumferential surface of said external ring and positioned on a rear surface side of said semiconductor chip.

10. A semiconductor device according to claim 1, wherein the external ring has an open top and an open bottom and is entirely spaced away from the semiconductor chip.

11. A lead frame device according to claim 3, wherein the external ring has an open top and an open bottom and is entirely spaced away from the semiconductor chip when the opening portion houses the semiconductor chip.

12. An electronic apparatus according to claim 5, wherein the external ring has an open top and an open bottom and is entirely spaced away from the semiconductor chip.

Although, as cited, Ohsawa teaches all of the limitations of the instant invention, including a device and an apparatus formed with a plurality of through holes or blind holes positioned entirely outside of a perimeter edge of the semiconductor chip, and a device comprising wherein the external connection terminal and an electrode on a printed wiring board are connected, these limitations do not appear to be explicitly taught in one embodiment containing all of the instant limitations. Nonetheless, in the alternative, it would have been obvious to combine these particular limitations of the embodiments of Ohsawa because it would facilitate

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miniaturization, manufacturing convenience and external electrical connection.

This is a continuation of applicant's earlier Application No. 09/009,248. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to the Customer Service Office, TC 2800, 703/306-3329.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/305-3431.



David E. Graybill
Primary Examiner
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D.G.